UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,902	02/04/2004	Eric Edwards	SON5180.85A (50T5528.01)	3886

8156　　　7590　　　12/08/2009		

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ART UNIT	PAPER NUMBER
2431	

MAIL DATE	DELIVERY MODE
12/08/2009	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ERIC EDWARDS and ROBERT SATO

_____

Appeal 2008-004810
Application 10/771,902
Technology Center 2400

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Decided: December 8, 2009

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Before HOWARD B. BLANKENSHIP, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges.*

SIU, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the

Examiner's rejection of claims 1-6, 8, and 10-30. Claims 7 and 9 have been

cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The disclosed invention relates generally to identifying opportunities

to capture content based on location (Spec. 1).

Independent claim 1 is illustrative:

> 1.   A method of identifying photographic opportunities,
> comprising:
>   maintaining a user profile describing the photographic interests
> of a user as content types selected from a number of content type
> categories within which the user has expressed interest;
>   wherein said content type specifies the category, or kind, of
> photo opportunity in which the user is interested;
>   determining a geographic location of a device;
>   identifying a plurality of suggestions from a photo opportunity
> database based on the geographic location of the device and matching
> of photographic interests as given by said content types within said
> user profile with the content type of the photo opportunity, wherein
> each suggestion indicates a unique photo opportunity;
>   transmitting the plurality of photo opportunity suggestions to
> the device;
>   receiving a user selection from the device chosen from the
> plurality of suggestions; and
>   transmitting additional information to the user regarding the
> selected photo opportunity to the device.

The References

The Examiner relies upon the following references as evidence in support of the rejections:

Baron   US 6,459,388 B1   Oct. 01, 2002
Hunter   US 2003/0020816 A1   Jan. 30, 2003
Wall   US 6,731,239 B2   May 04, 2004
                    (filed Jan. 18, 2002)

The Rejections

1. The Examiner rejects claims 1-5 and 21-28 under 35 U.S.C. § 102(b) as being anticipated by Baron.

2. The Examiner rejects claims 3, 6, 8, 10-16, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Baron and Wall.

3. The Examiner rejects claims 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Baron and Hunter.

4. The Examiner rejects claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Baron, Wall, and Hunter.[1]

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[1] The Examiner rejects claims 11 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Baron and Wall but rejects claims 17 and 18, which depend from claims 11 and 16, under 35 U.S.C. § 103(a) as being unpatentable over Baron and Hunter. Because claims 17 and 18 depend from claim 16 (which the Examiner rejects as being unpatentable over Baron and Wall), we assume that claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable under 35 U.S.C. § 103(a) over Baron, Wall, and Hunter.

ISSUE 1

Appellants assert that Baron fails to disclose "[t]he user profile recited in the claim '*describing the photographic interests of a user as content types selected from a number of content type categories within which the user has expressed interest; wherein said content type specifies the category, or kind, of photo opportunity in which the user is interested.*'" (App. Br. 9) and "*matching of photographic interests as given by said content types within said user profile with the content type of the photo opportunity*" (App. Br. 11).

Did Appellants demonstrate that the Examiner erred in finding that the combination of Baron and Wall discloses a user profile with content types as claimed and matching of the content types in the user profile with content type of a photo opportunity?

ISSUE 2

Appellants assert that the combination of Baron and Wall fails to disclose or suggest "changing geographic limitations . . . in the context of being based on the matching of content type" (App. Br. 24).

Did Appellants demonstrate that the Examiner erred in finding that the combination of Baron and Wall discloses or suggests dynamically varying the radius of geographic limits to the device?

ISSUE 3

Appellants assert that "it is improper to assert a holding of obviousness against the claim in view of [Baron and Wall]" (App. Br. 24) because "Wall is directed to different objects and operating principles than that of Baron, as well as the Applicant's claimed invention" (App. Br. 24), that the "rejection [is] based only on similarity of inventive concept or idea" (id.), that "advantages cannot be disregarded" (id. at 25), that the Examiner's rejection is "based on hindsight in view of applicant's teaching" (id.), that a "new principle of operation [is] utilized" (id.), that an unspecified teaching solves "a different problem" (id.), that (presumably) the Examiner's rejection lacks "specificity of suggestion to modify", that "elements in references are not equivalent", that the combination of references is "unworkable" and "useless" (id.), that there is " no need of element within references" (id.), that there is "no motivation to combine" (id.), that "obvious to try is not a standard of obviousness" (id.) and that "the invention is to be considered as a whole" (id.).

Did Appellants demonstrate that the Examiner erred in finding that it would have been obvious to one of ordinary skill in the art to have combined the Baron and Wall references?

ISSUE 4

Appellants assert that Baron and Wall fail to disclose or suggest "tightening <u>content type requirements</u> to alter the number of suggestions generated" (App. Br. 32).

Did Appellants demonstrate that the Examiner erred in finding that the combination of Baron and Wall discloses or suggests tightening a requirement that the content type of each suggestion match the user profile?

ISSUE 5

Appellants assert that Baron and Wall fail to disclose or suggest "updating the user profile in response to the images captured by the camera" (App. Br. 33).

Did Appellants demonstrate that the Examiner erred in finding that the combination of Baron and Wall discloses or suggests updating a user profile based on images captured by the device?

FINDINGS OF FACT

The following Findings of Facts (FF) are shown by a preponderance of the evidence.

1. Baron discloses that a "[d]atabase of sites 31 includes site information such as locations and descriptions of scenic views and photo-spots" (col. 6, ll. 22-24).

2. Baron discloses that "information to aid a user in selecting a nearby site for visiting, and navigational information for guiding the user to a preferred photo-spot for capturing a preferred view of the site" (col. 7, ll. 55-58).

3. Baron discloses that the user accesses information (that describes a location) in the database and "keys in a desire to visit the site" if "the user . . . determine[s] . . . [that] the site is worth visiting" (col. 7, ll. 63-66).

4. Wall discloses a "remote computer 14 uses parameters from the user profile to limit the amount of information being sent to a user information retrieval device" (col. 5, ll. 13-15).

5. Wall discloses that "the user profile can guide the content received from the remote databases 16" (col. 5, ll. 18-19).

6. Wall discloses "[i]f the user were traveling . . . the location combined with the user profile would result in retrieval and display of certain information" (col. 5, ll. 20-23).

7. Wall discloses that "the retrieved information may be customized . . . to give priority to topics included in a user profile" (col. 5, ll. 37-39).

8. Wall discloses that "the user can limit the amount of information that the processor 42 gathers by entering parameters in a user profile associated with the user information retrieval device" (col. 5, ll. 6-9).

9. Baron discloses that a database contains "photographs of the site which have been added to the database . . . by this user at a previous time" (col. 7, ll. 61-64).

PRINCIPLES OF LAW

35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted). "Anticipation of a patent claim requires a finding that the claim at issue 'reads on' a prior art reference." *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (citation omitted). "In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art." (*Id.*) (citation omitted).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

ANALYSIS

Issue 1

<u>Claims 1, 2, 4, 5, and 21-30</u>

As above, Baron discloses a database containing information pertaining to photo-spots and views at a location and provides information on the locations based on a user selection (FF 1-3). While Baron discloses information describing a location or site and directional information describing how to find the location or site (i.e., "navigational information"), the Examiner has not demonstrated that Baron also discloses a user profile containing information (or "content types") "within which the user has expressed interest" or that "specifies the category, or kind, of photo opportunity in which the user is interested," as recited in claim 1.

Rather, Baron discloses that the user selects a location deemed worthy of visiting (FF 3) from a database. The database contains data describing locations regardless whether the user has an interest in the location or not. In addition, while the Examiner shows that the user selects data to be received (i.e., data of interest), the Examiner has not demonstrated that Baron also discloses matching of content types in a user profile with content

type of a photo opportunity. In fact, the Examiner has not demonstrated that Baron discloses a user profile at all.

Independent claims 21 and 28 recite similar features as claim 1. Accordingly, we conclude that Appellants have met their burden of showing that the Examiner erred in rejecting independent claims 1, 21, and 28, and of claims 2, 4, 5, 22-27, 29, and 30, which depend therefrom.

Claims 3, 6, 8, and 10-20

Based on Appellants' arguments in the Appeal Brief, we will decide the appeal of the rejection of claims 3, 6, 8, and 10-20 with respect to issue 1 on the basis of claim 10 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

The "content type" as claimed is information in a user profile "in which the user has expressed interest," "specifies the category, or kind, of photo opportunity in which the user is interested," and is matched to generate a "number of suggestions" as recited in claim 10. As described above, Wall discloses a user profile containing information of locations or events of interest to a user (FF 4-5) that is used to identify and retrieve desired location information (i.e., "matched") (FF 6-7) and Baron discloses location information as including photo opportunities at the location (FF 1-2). Since the information as disclosed by Wall includes each of the claimed features of "content type," we agree with the Examiner that the combination of Baron and Wall discloses or suggests "content type" and "matching the content type" as claimed.

For at least the aforementioned reasons, we conclude that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claim 10, or of claims 3, 6, 8, and 11-20, which fall therewith with respect to issue 1.

Issue 2

Based on Appellants' arguments in the Appeal Brief, we will decide the appeal of the rejection of claims 3 and 10-20 with respect to issue 2 on the basis of claim 10 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants argue that in Wall, "no support is put forth how this [reducing the geographical distance around position coordinates] is done in combination with 'matching of the content type . . .'" (App. Br. 23). However, as described above, Wall discloses user preferences in a user profile and, based on the user preferences, data of interest is retrieved from a database. We agree with the Examiner that it would have been obvious to one of ordinary skill in the art, given the known concept of using preference data to identify corresponding data in a database, to have matched the preference data with the desired data in the database since performing matching of the data would have entailed no more than common sense to identify the matching data in the database. "[T]he common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (citing *KSR Int'l Co.*, 550 U.S. at

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413). In addition, such a result of obtaining the desired data from the database would have been an expected and predictable result from matching the data with preference data. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

Since Wall explicitly discloses modifying the geographic distance around position coordinates and it would have been obvious to one of ordinary skill in the art to match user preference data with desired matching data in a database, we disagree with Appellants' contention that Wall fails to disclose or suggest modifying a geographic position in the context of matching content types.

For at least the aforementioned reasons, we conclude that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claim 10, or of claims 3 and 11-20, which fall therewith with respect to issue 2.

Issue 3

Based on Appellants' arguments in the Appeal Brief, we will decide the appeal of the rejection of claims 3, 6, 8, and 10-20 with respect to issue 3 on the basis of claim 10 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

As set forth above, Wall discloses a user profile containing user preference information and matching the user preference information with

location information to provide information on locations of interest to the user. Also as described above, Baron discloses providing location information of interest to a user in which the location information includes photo opportunity information pertaining to the location of interest. We agree with the Examiner that it would have been obvious to one of ordinary skill in the art, given the known methods and systems of providing information of a location that is of interest to a user (Baron and Wall) by matching user preference information with location information (Wall) and also including in the provided information photo opportunity information (Baron), because doing so would have entailed no more than utilizing known methods and systems performing their known functions to achieve a predictable result (i.e., providing photo information (Baron) of locations of interest (Baron and Wall)). "[W]hen a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *KSR Int'l Co.*, 550 U.S. at 416 (citing *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976)).

Appellants assert that "Wall is directed to different objects and operating principles than that of Baron, as well as the Applicant's claimed invention" (App. Br. 24). However, we do not find that the "principles" of Baron (i.e., obtaining desired location information) is contrary to that of Wall (i.e., obtaining location information that is of interest to a user). In fact, we find no substantial difference between the principles of Baron and

Wall at all. Nor do Appellants point to any specific differences in the principle of the cited references.

Appellants provide an exhaustive list of proposed reasons why it would not have been obvious to one of ordinary skill in the art to combine the known features of Baron with those of Wall to achieve the expected result of obtaining desired information of locations of interest such as the "rejection [is] based only on similarity of inventive concept or idea" (id.), that "advantages cannot be disregarded" (id. at 25), that the Examiner's rejection is "based on hindsight in view of applicant's teaching" (id.), that a "new principle of operation [is] utilized" (id.), that an unspecified teaching solves "a different problem" (id.), that (presumably) the Examiner's rejection lacks "specificity of suggestion to modify", that "elements in references are not equivalent", that the combination of references is "unworkable" and "useless" (id.), that there is " no need of element within references" (id.), that there is "no motivation to combine" (id.), that "obvious to try is not a standard of obviousness" (id.) and that "the invention is to be considered as a whole" (id.). However, Appellants provide no support for any of these contentions, thereby failing to demonstrate that the Examiner erred in finding that it would have been obvious to combine the Baron and Wall references.

For at least the aforementioned reasons, we conclude that Appellants have not sustained the requisite burden on appeal in providing arguments or

evidence persuasive of error in the Examiner's rejection of claim 10, or of claims 3, 6, 8, and 11-20, which fall therewith with respect to issue 3.

Issue 4

Wall discloses that "the user can limit the amount of information that the processor 42 gathers by entering parameters in a user profile associated with the user information retrieval device" (col. 5, ll. 6-9). As set forth above, Wall discloses limiting the amount of information by entering parameters in a user profile (FF 8). Since the user limits the amount of information in the user profile (that contains the "content type" as described above), we agree with the Examiner that Wall discloses or suggests reducing suggestions "by tightening a requirement" since when one *limits* information, one would also *reduce* the information as well as both limiting and reducing information pertain to decreasing the amount of information.

For at least the aforementioned reasons, we conclude that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claim 8 with respect to issue 4.

Issue 5

As described above, Wall discloses a user updating a user profile by "entering parameters in the user profile" (FF 8). Also, Baron discloses a user inputting photographs into a database (FF 9). Thus, while Wall

discloses that it was known in the art to update a user profile by inputting data, Baron discloses that it was also known in the art that a user may input a photograph. We agree with the Examiner that it would have been obvious to one of ordinary skill in the art to have updated a user profile by inputting data (Wall) and to have included a photograph, which also constitutes data, in the entered data (Baron) since such a result would have been a predictable outcome (inputting data to update a profile, the data containing a photograph) from the combination of known elements as disclosed by Baron and Wall.

For at least the aforementioned reasons, we conclude that Appellants have not sustained the requisite burden on appeal in providing arguments or evidence persuasive of error in the Examiner's rejection of claim 19 with respect to issue 5.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have failed to demonstrate that the Examiner erred in:

1.   finding that Baron and Wall discloses a user profile with content types as claimed and matching of the content types in the user profile with content type of a photo opportunity (issue 1 – claims 3, 6, 8, and 10-20),

2.   finding that the combination of Baron and Wall discloses or suggests dynamically varying the radius of geographic limits to the device (issue 2),

3.   finding that it would have been obvious to one of ordinary skill in the art to have combined the Baron and Wall references (issue 3),

4.   finding that the combination of Baron and Wall discloses or suggests tightening a requirement that the content type of each suggestion match the user profile (issue 4), and

5.   finding that the combination of Baron and Wall discloses or suggests updating a user profile based on images captured by the device (issue 5).

However, Appellants have demonstrated that the Examiner erred in finding that the Baron discloses a user profile with content types as claimed and matching of the content types in the user profile with content type of a photo opportunity (issue 1 – claims 1, 2, 4, 5, and 21-28).

DECISION

We affirm the Examiner's decision rejecting claims 3, 6, 8, and 10-20 under 35 U.S.C. § 103. We reverse the Examiner's decisions rejecting claims 29 and 30 under 35 U.S.C. § 103 and claims 1, 2, 4, 5, and 21-28 under 35 U.S.C. § 102(b).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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